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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUAN-SHIAN CHEN
and MICHAEL X. YANG

Appeal 2008-0831
Application 10/770,737
Technology Center 1700

Decided: March 26, 2008

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 3, 5, 6, 9, and 21 through 28 in the Office Action mailed July 14, 2006. Claims 1 through 3, 5, 6, 9, and 25 were subsequently cancelled in the Amendment filed October 16, 2006 entered in the Office Action mailed October 27, 2006, leaving claims

21 through 24 and 26 through 28 on appeal. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We reverse the decision of the Primary Examiner.

Claim 21 illustrates Appellants' invention of an electroless processing system, and is representative of the claims on appeal:

21. An electroless processing system, comprising:

a factory interface having a substrate transfer robot positioned therein, the factory interface being configured to communicate with at least one substrate containing cassette; and

at least two substrate processing modules in detachable communication with the factory interface, each of the at least two substrate processing modules including a pretreatment/post treatment cell and an electroless processing cell.

The Examiner relies upon the evidence in these references (Ans. 2):

Verhaverbeke	US 2003/0045098 A1	Mar. 6, 2003
Hongo	US 6,921,466 B2	Jul. 26, 2005

Appellants request review of the following grounds of rejection advanced on appeal (App. Br. 8):

claims 21, 23, 24, and 26 through 28 under 35 U.S.C. § 102(e) as unpatentable over Hongo (Ans. 3); and

claim 22 under 35 U.S.C. § 103(a) as unpatentable over Hongo in view of Verhaverbeke (Ans. 4).

Appellants argue the claims in the first ground of rejection as a group. App. Br. 10-11. Thus, we decide this appeal based on claims 21 and 22. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

The basic issues in this appeal are whether the Examiner has carried the burden of establishing a prima facie case in each of the grounds of rejection advanced on appeal.

These issues turn on the threshold issue of the interpretation of the plain language of the second clause of claim 21. The terms used in this clause are given their broadest reasonable interpretation in their ordinary usage in the context of the claim as a whole as they would be understood by one of ordinary skill in the art, in light of the written description in the Specification, including the drawings, without reading into the claim any disclosed limitation or particular embodiment. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

We agree with Appellants (App. Br. 10-11; Reply Br. 2) that a reasonable interpretation of the terms of the second clause of claim 1 in light of the Specification is that each of the detachable processing modules must have at least the specified two different cells or units. Spec., e.g., ¶¶ 0006-0009, 0014, 0017, and 0026, and Figs. 1 and 2. Thus, contrary to the Examiner's position, claim 21, and claims dependent thereon, cannot be interpreted as "open to a single cell which is capable of providing electroless plating and pretreatment/post treatment of the substrate." Ans. 4.

In view of our interpretation of claim 21, we cannot sustain the Examiner's position with respect to the ground of rejection under § 102(e) over Hongo. Ans. 3-4 and 4-5. In order to establish a prima facie case of anticipation under this statutory provision, the Examiner must show that, as a matter of fact, Hongo describes to one skilled in this an electroless processing system that meets each and every limitation of claim 21, arranged as required therein. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997), and cases cited therein.

Thus, even though Appellants (App. Br. 11) do not dispute the Examiner's determination that detachable units 111 and 112 of Hongo's semiconductor processing apparatus¹ are each capable of performing both "pretreatment/post treatment" and "electroless processing" steps (Ans., e.g., 4-5), such teachings do not describe the claimed system within the meaning of § 102(e) as Appellants contend. App. Br. 10-11; Reply Br. 2. Indeed, the Examiner's contentions with respect to the claimed system encompassed by claim 21 vis-à-vis the teachings of Hongo are more akin to a determination of obviousness under § 103(a).

Accordingly, in the absence of a prima facie case of anticipation, we reverse the ground of rejection under 35 U.S.C. § 102(e).

The Examiner relies on the same claim construction and teachings of Hongo in combination with the teachings of Verhaverbeke to reject dependent claim 22 under § 103(a). Ans. 4. Appellants contend the Examiner's position in applying Hongo to independent claim 21 does not establish that Hongo would have taught the elements required by claim 21, and thus, claim 22, to one of ordinary skill in this art. App. Br. 13. We agree with Appellants that the Examiner has not addressed the issue of whether Hongo alone would have rendered claim 21 prima facie obvious to one of ordinary skill in this art within the meaning of § 103(a), and the further combination of Verhaverbeke with Hongo also does not address the same claim limitations with respect to claim 22. Indeed, the Examiner has not established that one of ordinary skill in this art armed with the knowledge in the art would have separated the functions performed by a

¹ See Hongo, e.g., col. 33, l. 59 to col. 50, l. 20, and Figs. 31, 36, and 45.

single unit of Hongo's system as illustrated in, for example, Fig. 31 thereof, into two different processing sections on that same unit. *See, e.g., B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582 (Fed. Cir. 1996) ("When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. This suggestion or motivation need not be expressly stated." (citation omitted)).

Accordingly, in the absence of a *prima facie* case of obviousness, we reverse the ground of rejection under 35 U.S.C. § 103(a).

The Primary Examiner's decision is reversed.

REVERSED

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